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MAR 18 2004

OFFICE OF PETITIONS

In re Application of :
Lonsky, Nguyen, and Sartain : DECISION REFUSING STATUS
Application No. 10/729,470 : UNDER 37 CFR 1.47(a)
Filed: 5 December, 2003 :
Atty Docket No. 18,693.1 :

This is in response to the petition filed under 37 CFR 1.47(a) on 10 December, 2003.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 5 December, 2003, with a declaration naming Werner Franz Wilhelm Lonsky, William Hung Nguyen, and Kevin Bradley Sartain as joint inventors and signed by joint inventors Lonsky and Sartain on behalf of themselves and joint inventor Nguyen. The present petition was also filed on 5 December, 2003.

Petitioners state that joint inventor Nguyen refused by telephone to sign the declaration.

A grantable petition under 37 CFR 1:47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1) and (2).

In regards to item (1), petitioners have not provided proof that Nguyen was ever sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).¹ While the petition includes a declaration containing Nguyen's signature filed in a prior provisional application, no declaration is required for a provisional application, and 37 CFR 1.63 does not permit the filing of a declaration, other than one filed in a prior nonprovisional application, to be filed in a subsequent application.² Further, there is no showing that Nguyen was ever sent or given a copy of the present application (specification, including the claims, drawings, if any, and the declaration).

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

In regards to item (2), the declaration contains is defective in that it contains non initialed and/or non-dated alterations.³ Specifically, there is an uninitiated and/or undated alteration

¹MPEP 409.03(d).

²See 37 CFR 1.63(d)(1).

³See 37 CFR 1.52(c).

in the signature block for joint inventor Lonsky. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67, identifying the application by serial number and filing date, signed by the inventor to whom the error or deficiency relates is required.⁴


Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 2011 South Clark Place
 Customer Window
 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.


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Office of Petitions

⁴37 CFR 1.67(a)(2).